

REMARKS

Applicant respectfully requests reconsideration and allowance of claims 1-10 that are pending in the above-identified patent application.

Rejections Under 35 U.S.C. § 103(a):

At pages 2-5 of the Office Action, the Examiner has rejected claims 1-7, 9, and 10 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,947,118 (“the ‘118 patent”) in view of U.S. Patent No. 5,871,010 (“the ‘010 patent”) and in further view of U.S. Patent No. 5,472,143 (“the ‘143 patent”). Applicant respectfully traverses the Examiner’s rejection.

Independent claim 1 recites “sloped and/or tapered parabolic-shaped elevations and/or depressions in a repeating pattern of an egg-carton arrangement”. (Emphasis added.)

The Examiner alleges that it would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the device of the ‘118 patent with the depressions taught by the ‘010 patent in order to result in the present invention as claimed in the instant application. The Examiner alleges that the only difference between the depressions of the ‘010 patent and the depressions of the instant application is the shape. The Examiner alleges that the teaching of the ‘010 patent for minimizing the area of contact between the medicament and the surface is in comparison to a flat surface with no grooves, and that the fact that parallel grooves would have a smaller contact area as compared to the sloped depressions in the May 9, 2008 Figure does not imply that the ‘010 patent teaches away from sloped/tapered depressions. The Examiner further alleges that a portion of the specification of the instant application implies that the sloped/tapered shape of the invention is not a critical feature. Applicant respectfully disagrees with the Examiner.

The sloped and/or tapered parabolic shaped elevations and/or depressions as claimed in independent claim 1 is not disclosed or suggested by the cited art of record. As presented in Applicant’s May 9, 2008 response, the ‘010 patent does not disclose or suggest sloped and/or tapered parabolic-shaped elevations and/or depressions as claimed in the instant application because the raised areas and/or indentations of the ‘010 patent device are not sloped and/or tapered between the raised areas and indentations. As previously conceded by the Examiner and as noted in the May 9, 2008 response, when the ‘010 patent is disclosing a curved or circular configuration in col. 5, lines 40-47, the ‘010 patent is disclosing the shape or path of the indentation or raised area, not the

surface structure between the raised areas and/or indentations. With regard to the '118 patent and the '143 patent, the Examiner previously conceded that the '118 and the '143 patents do not disclose or suggest elevations and/or depressions as claimed in the instant application. Indeed, the elevations and/or depressions as claimed in independent claim 1 of the instant application are structurally different than any raised areas and/or indentations disclosed or suggested in the '118 patent, the '010 patent, and the '143 patent.

As presented in Applicant's May 9, 2008 response and supplemental Figure, Applicant maintains that there is more than a mere difference in shape between the raised areas and/or indentations of the '010 patent and the elevations and/or depressions of the instant application. As previously stated, the '010 patent teaches minimizing the area of contact between the medicament and the surfaces of the inhaler. According to MPEP §2141.02(VI), "[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983). Taking the '010 patent as a whole, the teachings of the '010 patent apply the minimizing teaching for all surfaces of the substrate, and not just in comparison to a flat surface with no grooves. From at least the abstract, col. 1, lines 32-38; col. 2, lines 55-57; and col. 5, line 9 through col. 6, line 25, the '010 patent states that teaches minimization via indentations and/or raised areas. Specifically, from col. 1, lines 32-38, the '010 patent states that "at least one of such interior surfaces have indentations or raised areas therein...[to] provide a mechanism for minimizing the area of contact between the medicament and the surfaces of the inhaler". (Emphasis added.) From col. 5, lines 9-12 and col. 5, lines 22-26, respectively, the '010 patent further supports such a minimization modification by stating that "[t]he inhaler substrate is preferably modified to minimize the surface area of the contact between the particles of the powder and the surface of the substrate...", and "[t]he surface area of contact can be minimized, for example, by providing indentations in the plane of the surface, or by providing raised areas in the plane of the surface." (Emphasis added.) Indeed, the '010 patent teaches modifying the surfaces of the inhaler to minimize the contact between the medicament and the surfaces of the '010 patent device, regardless of whether the surface already has indentations and/or raised areas or is flat.

In contrast, as maintained from Applicant's May 9, 2008 response and supplemental Figure, the parabolic-shaped elevations and/or depressions as claimed in independent claim 1 of the instant

application do not minimize the contact between the medicament and the surface of the inhaler. Applicant established in the May 9, 2008 response that the supplemental Figure submitted therewith depicts the particles and surface of the '010 device in accordance with col. 6, lines 12-17 of the '010 patent. As depicted in the May 9, 2008 supplemental Figure, the surface area of the present invention as claimed in independent claim 1 in contact with the particle is not minimized because the surface of the device of the '010 patent achieves even less contact, i.e., is minimized as taught in the '010 patent. As defined in Webster's Unabridged Third New International Dictionary (2002), 'minimize' means "to reduce to the smallest [and not smaller] possible number, degree, or extent". (Emphasis added.) The smallest number applies to all possibilities, i.e., when compared to all surfaces with or without indentations and/or raised areas. Because the '010 patent teaches indentations and/or raised areas having the smallest or minimized contact with the medicament, those skilled in the art reading the '010 patent would not arrive at the present invention because the teachings of the '010 patent disqualify the shape of the elevations and/or depressions as claimed in independent claim 1 of the instant application as a minimization possibility. Therefore, the '010 patent teaches away from employing elevations and/or depressions as presently claimed in the instant application because such claimed elevations and/or depressions would increase the contact area between the medicament and the surfaces of the inhaler. For example as shown in the May 9, 2008 Figure, particle 1 has a larger area of contact with the sloped and/or tapered parabolic-shaped depression due to the sloped and/or tapered characteristics of the parabolic-shaped depression. As such, a sloped and/or tapered parabolic-shaped elevation and/or depression has a larger surface area of contact with a particle than the parallel grooves as disclosed or suggested in the '010 patent, and the elevations and/or depressions as claimed in independent claim 1 of the instant application function differently than the raised areas or indentations, e.g., the parallel grooves, disclosed or suggested in the '010 patent.

Moreover, the specification of the instant application does not imply that the sloped/tapered shape of the invention is not a critical feature. On the contrary, the Examiner is not considering the specification of the instant application as originally filed in its entirety. From page 22, lines 1-5, the specification of the instant application states that "[t]he properties of the surfaces thus obtained are optimum when the elevations have rounded tips." (Emphasis added.) Indeed, rounded tips as taught in the specification of the instant application have a sloped/tapered shape, and thus, the specification

of the instant application explicitly teaches that the sloped/tapered shape of the instant invention is a critical feature. Because the '010 patent teaches away from the invention as claimed in independent claim 1 of the instant application and because different functionality and a critical teaching exists in the specification of the instant application, the teachings of the '118 patent, the '010 patent, and the '143 patent cannot, and do not, result in the present invention as claimed in independent claim 1 of the instant application. In view of the above, Applicant submits that independent claim 1 is, therefore, patentable. As claims 2-7, 9, and 10 depend from independent claim 1, and recite additional patentable features, claims 2-7, 9, and 10 are, therefore, likewise patentable.

In the Office Action at page 5, the Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over the '118 patent, the '010 patent, and the '143 patent in further view of U.S. Patent No. 4,889,114 ("the '114 patent"). The '114 patent does not cure the aforementioned deficiencies regarding amended independent claim 1, from which claim 8 depends. Therefore, Applicant submits that claim 8 is, therefore, likewise patentable.

In view of the above, Applicant respectfully requests that the Examiner's §103 rejections be withdrawn.

Conclusion:

In view of the foregoing, Applicant submits that the instant claims are in condition for allowance. Early and favorable action is earnestly solicited. The fee for the RCE is included herewith. In the event there are any fees due and owing in connection with this matter, please charge same to our Deposit Account No. 11-0223.

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Respectfully submitted,

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